

Application Serial No. 09/975,381

REMARKS

1. Applicant thanks the Examiner for his thoughtful assistance provided during a telephone interview on August 29, 2007. During said interview, Applicant pointed out
5 that the rejection of the independent claims is improperly maintained because the Examiner relies on page 4 of "Pricescan" as teaching or suggestion the claim element "distinguishing online providers from offline providers in said integrated list." Applicant pointed out that, while page 4 of Priceline mentions the inclusion of brick-and-mortar retailers in an integrated listing, there is no teaching or suggestion of
10 distinguishing between them in the integrated directory. The Examiner contends that "Pricescan" inherently teaches the claim language. As described in detail below, Application respectfully disagrees.

2. **35 U.S.C § 103**

15 Claims 1, 3 and 6-25 stand rejected as being unpatentable over Pricescan in view of U.S. patent no. 6,594,666 ("Biswas"). Applicant respectfully disagrees. The Examiner relies on Pricescan, page 4 as teaching or suggesting the claim element "distinguishing online providers from offline providers in said integrated list," contending that, although there is no explicit teaching in the
20 combination of the claim element, Pricescan, page 4, inherently teaches the claim element.

The relevant teaching from Pricescan is a Q&A segment answering the question "Does a vendor need to have a web site to be included in the shopping guide?" The answer relates that product and pricing information is gathered on a
25 daily basis and entered into a searchable database, which is updated daily. While the foregoing language may imply that both online and exclusively brick-and mortar retailers are both listed in the shopping guide, there is no teaching that the shopping guide provides any way of distinguishing between online and brick-and mortar retailers.

30 Applicant has diligently searched pages 5-12 of Pricescan and can find no teaching to suggest that Pricescan distinguishes online retailers from brick-and-mortar retailers. Thus, the contention that Pricescan inherently teaches the claim limitation appears to be based on the Examiner's conclusion that Pricescan could include the claim feature.

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However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 (IV), quoting *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Additionally, to establish inherency, extrinsic evidence "must make clear

5 that the missing descriptive matter is necessarily present in the thing described in the reference" MPEP § 2112 (IV) quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The Examiner provides no rationale or extrinsic evidence that the system described in Pricescan must necessarily describe the subject matter of claim

10 Claims 1. Accordingly, there is no teaching or suggestion of the claim feature in Pricescan.

Biswas, describing a location-aware application development framework, adds nothing to Pricescan. Accordingly, the combination of Pricescan and Biswas fails to teach or suggest:

"A computer-implemented method for providing an integrated electronic list of providers, comprising the steps of:

determining at least one online provider for an item;

determining at least one offline provider for the item;

wherein the determining steps follow a request for a product;

wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored;

wherein when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location; and

integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item; and

distinguishing online providers from offline providers in said integrated list."

Therefore, the combination fails to teach or suggest all elements of the claimed invention. Accordingly, because there is no teaching or suggestion of the subject matter of claim 1 in the combination, the present rejection is deemed

30 improper.

The foregoing remarks apply equally to claims 22 and 23.

In view of their dependence from allowable parent claims, the dependent claims are deemed allowable without any separate consideration of their merits.

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For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

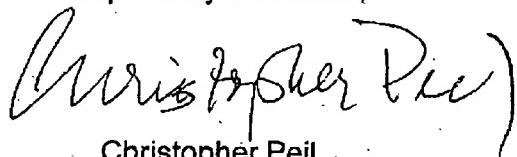
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CONCLUSION

In view of the foregoing, the Application is deemed to be in allowable condition. Accordingly, Applicant seeks favorable reconsideration and prompt allowance of the claims. Should the Examiner find it helpful, he is encouraged to contact applicant's attorney at 650-474-8400.

Respectfully submitted,

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